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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

YU, GINA C

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 02/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/928,110	DOLE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Gina C. Yu	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on November 5, 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Receipt is acknowledged of Amendment filed on November 5, 2003. Claims 1-13 are pending. Claim rejections made under 35 U.S.C. § 112, second paragraph, as indicated in the previous Office action dated July 1, 2003, are withdrawn in view of applicants' claim amendment. Claim rejection made under 35 U.S.C. §102 (b) as anticipated by Menda et al. (US 4000317) as indicated in the same Office action is withdrawn and modified in view of the claim amendment. Claim rejection made under 35 U.S.C. § 102(b) as anticipated by Strianse et al. (US 4362715) is withdrawn in view of the claim amendment. Claim rejection made under § 103 (a) as unpatentable over Neova product label in view of Gerstein (US 5139771) is withdrawn in view of the claim amendment. Claim rejection made under § 103(a) as unpatentable over Neova product label in view Gerstein, and further in view of Carbot Technical Data is also withdrawn in view of the claim amendment. New rejections are made. Claim rejection made under § 103(a) as unpatentable over Jung (US 5139782) is withdrawn and modified to meet the new claim limitation.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-3, 10, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Menda et al. (US 4000317) ("Menda").

Menda discloses a composition comprising 2.0 % wt of pyrogenic colloidal silica, 48.2 % wt of water, 0.0008 % wt of FD & D Blue dye #1. See Example 3. The reference teaches in col. 7, lines 6 – 38 that up to 25 % of the pyrogenic colloidal silica can be used. See particularly lines 23-25 which teaches that the preferred range is within 1.5-10 %. While claim 1 recites, “the amount of the colorant and the silica is effective to provide a facial mask composition that changes color upon drying”, applicants’ specification defines that such amount of the colorant typically ranges from about 0.0001 to about 0.1, while the amount of silica is in the range of 1-99 % by weight. See spec. p. 3, lines 8 – 33. Examiner views that the phrase “to provide a facial mask composition” is an intended use or purpose of the composition and thusly no patentable weight is given the phrase. Instant claims are drawn to a composition, rather than a method of using the combination of colorant and silica to make a color-changing mask. The phrase “that changes color upon drying” is viewed a physical property of any composition that contains at least one colorant and the silica as recited in claim 1.

2. Claims 1-3 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Dulog et al. (US 6106818) (“Menda”).

Dulog discloses a composition comprising 1.50 % of titanium dioxide, 12% of silica, and water. See Example 4. See instant claims 1. As explained above, the phrase “to provide a facial mask composition” is not given patentable weight, for it is an intended use or purpose of the composition. The phrase “that changes color upon

drying" is viewed a physical property of any composition that contains at least one colorant and the silica as recited in claim 1.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1-10, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neova product label in view of Dulog et al. (US 6106818) and Gerstein (US 5139771).

Neova product label discloses silica-containing skin mask composition. The composition comprises water, silica, glycerin, polysorbate 20, and preservatives. Neova product label also discloses that silica in the composition absorbs excess oils while glycerin provides moisture to the skin. The composition is said to cleanse and provide skin fresh feel. See instant claims 12 and 13. The method of using the composition is also disclosed. See Directions; instant claim 11.

Neova also fails to teach the amount of the silica used, or adding colorant to the composition.

Dulog teaches skin cleansing composition comprising 12 % of silica, which is said to absorb oil. See Example 4; See also col. 11, lines 10 – 32. The reference further teaches using 0.1-20 % absorbent and 0.1-20 % pigments. See col. 1, lines 51-55. The reference teaches that the pigments are used to provide coloration to enhance consumer appeal and assist the absorbent in absorbing oil or sebum. See col. 11, lines 35 – 55.

Neova fails to teach quantity of the ingredients used.

Gerstein teaches skin-cleansing mask compositions. See abstract. The reference teaches to add colorants to "impart a pleasant color" to the composition. See col. 5, lines 27 – 33; instant claim 1. Example 5 employs FD & C green # 5, and all of the FD&C colors approved for cosmetic use and inorganic pigments are said to be suitable for the invention. While Gerstein does not disclose the recited colorants in instant claim 10, examiner takes the position that, in view of the general teaching in the reference, the difference in color is a mere preference of a skilled artisan and not a nonobvious selection over the prior art. See also Examples 4, 8, and 9 for the use of various colorants.

Gerstein further teaches that 0.1-7 % of surfactants, such as polysorbate 20, can be added in the compositions. See col. 4, line 52 – col. 5, line 14; col. 5, lines 43 – 64; see instant claims 5 and 6. Humectants such as glycerin (or glycerol) and moisturizer can be used up to 1.0 % and 3.0 %, respectively. See col. 4, lines 38 – 51; col. 5, lines 33 – 43; see instant claims 7-9. Using glycerin, propylene glycol, polyethylene glycol, and ethoxylated lanolin alcohols up to 2.0 % as plasticizer is also suggested. See col. 5, lines 17 – 21.

Given the teaching of the silica mask in Neova, one having ordinary skill in the art at the time the invention was made would have been motivated to look for the prior art such as Dulog for the specific amount of silica that is effective to absorb oil from the skin. It would have been also obvious to the skilled artisan to have modified Neova mask composition by adding colorants, as motivated by Gerstein, because of the of the

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expectation of successfully producing a colored mask composition. The claimed invention is a composition with a particular characteristic. While the combined references do not explicitly provide that the color change occurs as the composition dries, examiner takes the position that the same composition as recited in the instant claims would obviously have same color changing property upon drying, absent evidence indicating to the contrary.

All components in the instant claims are known. Nothing nonobvious or unexpected is seen in combining conventional ingredients well known in cosmetic art. See MPEP § 718.02.

2. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Neova product label in view of Dulog and Gerstein as applied to claims 1-10, 12, and 13 above, and further in view of Cabot Technical Data.

While Neova product label, discussed above, teaches that silica is effective in absorbing excess oil, as discussed above, the reference fails to disclose the type of silica used in the composition.

Cabot Technical Data teaches fumed silica useful in wide range of cosmetic products. The reference teaches that the fumed silica adsorbs excess oil on the skin. See p. 5, Powders.

It would have been obvious to a skilled artisan at the time the invention was made to have looked to the prior art such as Carbot Technical Data for a specific type of silica, and used the disclosed fumed silica therein in formulating the skin-cleansing mask composition of the combined references because of the expectation of

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successfully producing a skin-cleansing mask that would be effective in removing excess oil.

3. Claims 1-4 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jung (US 5139782).

Jung teaches facial cleansing mineral composition comprising silica zeolite (silica molecular sieve). See abstract. The reference teaches that "colorants may be aesthetically desirable", while absence of colorants is acceptable as well. Jung further teaches to add polyols such as propylene glycol and sorbitol for conditioning the skin. See col. 4, lines 28 – 39. Examples 1-7 show the workable range of the amount of silica.

While the reference does not explicitly provide that the color changes as the composition dries, examiner notes that the color change is an obvious property of the prior art composition which otherwise meets the limitation of the instant claims, absent evidence indicating to the contrary.

### ***Response to Arguments***

Applicant's arguments filed November 5, 2003 have been fully considered but they are not persuasive in part and moot in view of the new grounds of rejections in part.

Applicants' arguments against the previous rejections made less than 35 U.S.C. § 102(a) are moot in view of the new grounds of the rejection.

In rebutting the obviousness rejection made in view of Neova and Gerstein, applicants argue that the combine reference fails to suggest or provide motivation "to



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incorporate a colorant into the Neova composition in order to obtain a facial mask composition that changes color when the composition is dry". Examiner respectfully points out that the issue in this case is not whether the combined references teach the same method of using colorants in the Neova composition. Rather, at issue is whether it would have been obvious to add colorants in the Neova facial mask composition at all. In response to applicant's argument that applicants had different reason to combine colorants in the Neova composition, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). By teaching that colorants provide aesthetic benefits to cosmetic cleansing mask composition, the Gerstein reference provides ample motivation for a routineer to add colorants in the Neova mask formulation. The color-changing property of the resulting composition would naturally flow from the suggested combination of the Neova/Gerstein references, and thusly is an obvious in view of the prior art.

Applicants' argument that the Jung reference also fails to teach the color-changing property of the composition is also unpersuasive for the above reason. The prior art composition, if combined as taught by the reference, comprises the same components within the same weight amount as the claimed composition. While applicants assert that the color-changing property does not necessarily flow from the teachings of the reference, applicants provide no evidence to show that the otherwise same compositions have different properties.

***Conclusion***

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 703-305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu  
Patent Examiner

  
**SREENI PADMANABHAN**  
**SUPERVISORY PATENT EXAMINER**

2/2/04